

Neifeld Docket No: INVE0010-5

Application/Patent No: 09/879,825

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File/Issue Date: 6/12/2001

Inventor/title: Barnett/M/S for Electronic Distribution of Product Redemption Coupons

Examiner/ArtUnit: Duran/3622

ENTITY STATUS: Small

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 APPEAL BRIEF IN RESPONSE TO OFFICE ACTION

Sir:

In response to the office action mailed 4/25/2001, 2009, which was in response to the amendment filed 3/18/2011, and subsequent to the notice of appeal filed 7/25/2011, the applicant files this brief in support of the appeal.

The \$620 fee for the appeal brief is paid herewith via EFS submission.

I. **37 CFR 41.37 (a)(1) AND (2) - NOTICE OF APPEAL, BRIEF, AND FEES**

Claims have been twice rejected. A notice of appeal was filed 6/20/2011. The fee for the Notice of Appeal was filed with the notice of appeal. The fee for the Appeal Brief is paid herewith.

II. **37 CFR 41.37(b) - DISMISSAL OF APPEAL IF BRIEF AND FEES UNTIMELY**

The filing is timely. Accordingly, this subsection is not relevant.

III. **37 CFR 41.37(c)(1)**

The brief contains items (i) to (x) of this subsection.

A. **37 CFR 41.37(c)(1)(i) REAL PARTY IN INTEREST**

The real party in interest is Catalina Marketing Corporation, a Delaware corporation.

B. **37 CFR 41.37(c)(1)(ii) RELATED APPEALS AND INTERFERENCES**

There are related appeals.

The related appeals are:

Docket No.	AppNo	AppealNo	Appeal docket date
INVE0010-1	NO APPEAL		
INVE0010-2	NO APPEAL		
INVE0010-3	09/754,378	BPAI, 2005-2439	DECIDED
INVE0010-3	09/754,378	CAFC, 2007-1047	DECIDED
INVE0010-4	09/879,823	2005-2686	DECIDED
INVE0010-5	09/879,825	2007-0794	DECIDED
INVE0010-5	09/879,825	Not yet assigned (this appeal)	
INVE0010-6	10/871,381	2011-007957	4/28/2011
INVE0010-7	11/056,171	2011-010648	7/8/2011
INVE0010-8	12/247,549	Not yet assigned	
INVE0010-9	11/056,160	NO APPEAL	

INVE0014-1	09/321,597	BPAI	
INVE0014-1	09/321,597	CAFC	
INVE0015-1	09/451,558	2009-006888	DECIDED
INVE0016-1	09/537,793		
INVE0017-1	09/543,735		

All these cases have the same inventive disclosure and 35 USC 120 priority claimed date.

**C. 37 CFR 41.37 (c)(1)(iii) -STATUS OF CLAIMS. A STATEMENT OF THE STATUS OF ALL THE CLAIMS IN THE PROCEEDING (E.G., REJECTED, ALLOWED OR CONFIRMED, WITHDRAWN, OBJECTED TO, CANCELED) AND AN IDENTIFICATION OF THOSE CLAIMS THAT ARE BEING APPEALED**

Claims 1-46 are canceled.

Claim 47 is pending

Claims 48-56 are canceled.

Claim 57 is pending.

Claims 58-63 are canceled.

Claims 64-73 are pending.

The appellant appeals the rejections of all pending claims: 47, 57, and 64-73.

Claims 47, 57, 68, and 71 are the independent claims.

**D. 37 CFR 41.37(c)(1)(iv) STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION**

No amendment was filed subsequent to a final rejection.

**E. 37 CFR 41.37(c)(1)(v) SUMMARY OF CLAIMED SUBJECT MATTER**

Claims 47 and 57 are, respectively, system and method claims for distributing and redeeming electronic coupons. They define a system/method comprising:

a first server system {**Fig. 1, internet web site, unnumbered; coupon distributor 16,**

**coupon redemption 13; see numbered page 30:20-28 embodiment (physical layout of functions within the system matter of designer choice); numbered page 32:16-30, embodiment in which Internet site provides functions of online service provider 2; user may access the coupon repository by accessing the Internet site}, including a computer processor and associated memory, said first server system being connected by a communications channel {Fig. 1, "optional access"} to a client system {Fig. 1, personal computer 6}, said first server system being adapted for transmitting an electronic coupon {Fig. 1, "4 coupon requested and user data" line, and line having arrows pointing from online service provider 2 to personal computer 6, and numbered page 32:18-20} to said client system over said communications channel;**

**said client system including a computer processor and associated memory {Fig. 1, personal computer 6}, said client system being adapted for storing said electronic coupon in said memory {Fig. 1, e.g., "coupon print data", and Fig. 1 dashed arrow pointing from personal computer 6 online service provider 2 named "Electronic Redemption"; Fig. 2 "DOWNLOAD COUPON DATA 30a"; see numbered page 20:11-14 disclosing coupon data stored in downloaded coupon data file 30a of personal computer 6};**

**a second server system connected to said communications channel {Fig. 1, online service provider 2}, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system {numbered page 24:26 to 25:1 disclosing coupon upload routine 32cc "is called automatically and without user request whenever the user requests a coupon download package from the online service provider 2."; and numbered page 33:1-5 online service provider performs all coupon data management for personal computer 6 "In another alternative embodiment of the present invention, all coupon data management functions are carried out by the online service provider 2 rather than by the offline coupon data management routines 32"}, said second server system further being adapted to redeem said electronic coupon {Fig. 1, dashed arrow pointing from Personal computer 6 to Online Service Provider 2 referred to as "Electronic Redemption"; numbered page 26:20 to 27:2 disclosing "the coupon may be redeemed electronically by sending the coupon data in the output buffer via the data**

**communications interface 20 back to the online service provider 2."}; and**

wherein said electronic coupon includes data uniquely identifying the coupon relative to all other coupons transmitted by said first server system **{Numbered page 16:27 to 17:5 (uniqueness)}**;

wherein said associated memory of said first server system defines a database **{Figs. 6, 10, database 40, numbered page 15:12-15; numbered page 9:4-9; numbered page 12:8-11}**;

wherein said database stores coupon offer data defining available coupon offers **{Figs. 6, 10, database 40, numbered page 15:12-15; numbered page 12:8-11}**, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records **{Numbered page 30:1-8 and 16-28 (Internet web site provides data repository and functions)}**;

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records,

(2) information regarding coupons redeemed;

(3) data indicating which of said available coupon offers are to be offered;

said first server system programmed to respond to receipt over a network of a coupon request prompt from said client system, said coupon request prompt including a particular user identification and identification of a particular one of said available coupon offers, by transmitting from said server system to said client system, data defining a particular coupon **{Fig. 1, arrow from Internet Web Site to Personal Computer 6, identified as "Coupons Requested" and Fig. 1 arrow 4 from Personal Computer 6 to Online Service Provider 2 identified as "Coupon Request and User Data"}**,

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification **{Numbered page 16:27 to 17:5 (uniqueness)}**; and

said first server system being programmed to respond to receipt from a coupon redemption network address of said second server system, of coupon redemption data indicating

an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed {**Numbered page 12:26 to 13:2; page 25:29 to page 26:12 (concept of validation); Page 26:9-12 "disallow further redemption"; numbered page 26 line 25 (electronic redemption concept); numbered page 27:5-21 (used coupon deletion routine 32e; numbered page 30:20-28 embodiment (physical layout of functions within the system matter of designer choice; expanded redemption center))**}.

Claims 68 and 71 are, respectively, system and method claims. The define a system and method for electronically distributing and tracking redemption of coupons, comprising:  
a server system including a computer processor, associated memory, an input for receiving data, and an output for outputting data {**Fig. 1, internet web site, unnumbered; coupon distributor 16, coupon redemption 13; see numbered page 30:20-28 embodiment (physical layout of functions within the system matter of designer choice); see numbered page 32:16-30, alternative embodiment in which Internet site provides functions of online service provider 2; user may access the coupon repository by accessing the Internet site; Fig. 1, online service provider 2; numbered page 24:26 to 25:1 disclosing coupon upload routine 32cc "is called automatically and without user request whenever the user requests a coupon download package from the online service provider 2."; and numbered page 33:1-5 online service provider performs all coupon data management for personal computer 6 "In another alternative embodiment of the present invention, all coupon data management functions are carried out by the online service provider 2 rather than by the offline coupon data management routines 32"**};

wherein said memory defines a database;

wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records;

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all

other records of said user records,

(2) information regarding coupons redeemed;

(3) data indicating which of said available coupon offers are to be offered;

said server system programmed to respond to receipt over a network of a coupon request prompt, said coupon request prompt including a particular user identification; and identification of a particular one of said available coupon offers, by transmitting from said server system to a client computer associated with said particular user identification, data defining a particular coupon {**Fig. 1, arrow from Internet Web Site to Personal Computer 6, identified as "Coupons Requested" and Fig. 1 arrow 4 from Personal Computer 6 to Online Service Provider 2 identified as "Coupon Request and User Data"**},

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification {**Numbered page 16:27 to 17:5 (uniqueness)**}; and

said server system being programmed to respond to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed {**Numbered page 12:26 to 13:2; page 25:29 to page 26:12 (concept of validation); numbered page 26:9-12 "disallow further redemption"; numbered page 26 line 25 (electronic redemption concept); numbered page 27:5-21 (used coupon deletion routine 32e; numbered page 30:20-28 embodiment (physical layout of functions within the system matter of designer choice; expanded redemption center)**}.

F. **37 CFR 41.37(c)(1)(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The appellant requests review of all grounds of rejection. These are the rejections under 35 USC 103 of all claims as obvious based upon combinations of Von Kohorn, USP 5,227,874 (herein D1); Saigh, USP 5,734,823 (herein D2); and Cameron, USP 5,592,378 (Herein D3).

The appellant notes that the office action appealed from formally identified rejections under 103 based upon (1) D1 and D2, and also (2) rejections under 103 based upon D1, D2, and D3. However, the substantive arguments in the office action appealed from allege that the claims were obvious based solely upon D1, were obvious based solely upon D1 and D2, were obvious based solely upon D1 and D3, and were obvious based upon D1, D2, and D3.. Accordingly, identifying in this brief the grounds as (1) 103 based upon D1 and D2 and (2) 103 based upon D1, D2, and D3, would not correspond to the substantive basis for rejection identified in the office action appealed from.

**G. 37 CFR 41.37(c)(1)(vii) ARGUMENT IN WHICH EACH GROUND OF REJECTION IDENTIFIED UNDER SECTION 37 CFR 41.37(c)(1)(vi) IS TREATED IN A SEPARATE SECTION**

See the following sections.

**IV. GROUND OF REJECTION - Obviousness based upon Von Kohorn, USP 5,227,874 (herein D1); Saigh, USP 5,734,823 (herein D2); and Cameron, USP 5,592,378 (Herein D3)**

**A. DISPUTED FACTUAL ASSERTIONS FROM OTHER RELATED PROCEEDINGS/PAPERS**

The appellant is required by rule to dispute factual assertions in order to avoid waiver. The Office Action appealed from (herein after OA) contains assertions relating to BPAI and CAFC decision in related proceedings. To avoid waiver, the appellant first identifies and reviews those OA assertions, and compares them to the document in the related proceedings.

**STATEMENTS REFERRING TO OTHER JUDICIAL DECISIONS**

The examiner makes the following statements, referring to judicial decisions in related cases. The appellant provides clarification, upon review of the actual decisions.

At OA 6:4-7, and repeated at OA 17:17-20, and substantially repeated at OA 20:6-7 and OA 25:15-18: "Von Kohorn discloses the structure for two way communication between the end user device and the place of redemption (BPAI affirmed on 8/3/10 on pages 5, 6 in related case



09/451,558)." The relevant portion of that Decision reads as follows: "We also do not find Appellants' argument that Von Kohorn does not disclose a communication link between the point of sale system and the response unit persuasive. We agree with the Examiner that there is a communication link between the point of sale system 906 and the response unit or electronic coupon dispenser 206c through the data facility 904 and central station 202. We note that the claim does not require direct communication between the response unit and the point of sale system."

Accordingly, the applicant agrees that the BPAI concluded that Von Kohorn discloses "that there is a communication link between the point of sale system 906 and the response unit or electronic coupon dispenser 206c through the data facility 904 and central station 202."

At OA 8:20-9-25, and substantially repeated at OA 20:11-14, and at OA 26:1-3: "Von Kohorn explicitly discloses electronic issuing of coupons (affirmed by CAFC in related cases 09/754,378 and 09/543,735). The CAFC affirmed electronic issuing of coupons in the independent claims of CAFC affirmed rejections with Von Kohorn in view of Saigh for 09/754,378 and 09/543,735. Also, the CAFC indirectly affirmed the electronic redemption of coupons via claims dependent claims 86 and 108, respectively." The CAFC decision in related case 09/754,378 (INVE0010-3) was per curiam, without an opinion, and dated 10/11/2007. The BPAI decision in 09/754,378 indicates that the BPAI reviewed double patenting rejections, 112 rejections, and 103 rejections, at page 6, affirmed the double patenting and 103 rejections, at page 16, and made no changes to its decision upon reconsideration. Accordingly, the CAFC per curiam affirmance in 09/754,378 does not mean that the CAFC affirmed that "Von Kohorn explicitly discloses electronic issuing of coupons". The CAFC decision in related case 09/543,735 (INVE0017-1) was also per curiam, without an opinion, dated 10/11/2007. The BPAI decision in 09/543,735 indicates that the BPAI reviewed double patenting rejections, 112 rejections, and 103 rejections, at pages 2-3, reversed some of the 112 rejections, affirmed the double patenting rejections, and affirmed the 103 rejections, at page 16, and thereafter denied reconsideration in response to a request for rehearing. Accordingly, the CAFC per curiam affirmance in 09/543,735 does not mean that the CAFC affirmed that "Von Kohorn explicitly discloses electronic issuing of coupons". The CAFC decision was per curiam, not indicating which rejections it found dispositive. Accordingly, the appellant does not agree that the CAFC

affirmance in the foregoing two cases is relevant to what Von Kohorn discloses.

At OA 12:2-3, and OA 29:4-5: "Also, the CAFC affirmed rejections with Von Kohorn in view of Saigh for 09/754,378 and 09/543,735." The applicant disagrees because for the reasons just explained the basis of the CAFC per curiam affirmance is not specified.

At OA 12:13-17, and at OA 21:10-13, and at OA 29:16-19: "Alternatively, Cameron discloses using the Internet or a network (5:13-16; Fig. 2) and redeeming coupons electronically via a network (Figs. 13, 15; 11:10-15). Examiner notes that the use of Cameron for these features is already affirmed by the BPAI in this case 09/879,825 (see BPAI decision for 09/879,825 dated 8/21/2008 pages 31-34 and page 37, "The Appellant's have not otherwise shown prejudicial error")." The BPAI decision for 09/879,825 (INVE0010-5) dated 8/21/2008 at page 3 identifies 5 references and four sets of rejections, under 112, and 103. One of the references on page 3 is Cameron, US 5,592,378. Of the sets of rejections identified on page 3, one is under 103 and identifies the 103 evidence as Nichtberger, Valencia, and Cameron, and this rejection rejects claims 52 and 63. However, the BPAI decision for 09/879,825 (INVE0010-5) dated 8/21/2008 pages 31-34 is a portion of a transcript of oral argument identifying Mr. Gatto for the appellant and APJs Moore and Torczon; it does not refer to Cameron. And BPAI decision page 37 does not refer to Cameron, but does indicate by absence of discussion that the Nichtberger, Valencia, and Cameron 103 rejection of claims 52 and 63 was affirmed. In summary, the BPAI decision for 09/879,825 (INVE0010-5) dated 8/21/2008 pages 31-34 and 37 does not show that "Cameron discloses using the Internet or a network (5:13-16; Fig. 2) and redeeming coupons electronically via a network (Figs. 13, 15; 11:10-15).".

At OA 4:2-4: "Applicant states that the claims can be interpreted as the functions of coupon distribution, analysis, and redemption all occurring at a central location or website." In response, that characterization is inaccurate. That is not what the applicant stated. What the applicant stated was "The claims now pending reflect the server centric embodiment in which the redemption center also performs web site and database functions (via limitations added to independent claims 47 and 57), which limitations also appear in new independent claims 66 and 69." That passage did not state that "coupon distribution, analysis, and redemption all occurring at a central location or website." Claim 47, in fact, recites "said first server system being programmed to respond to receipt from a coupon redemption network

address of said second server system" which indicates that claim 47 defines a distinct address for said second server system. Newer claim 68 avoids this additional server system and additional address limitation.

**B. ESTOPPEL ARGUMENTS APPLICABLE TO ALL  
PENDING CLAIMS: 47, 57, AND 64-73**

In summary, the examiner reiterates the same basis for rejections that were found untenable in the prior BPAI decision in this case resulting in reversal of the prior 103 rejection based upon Von Kohorn and Saigh (D1 and D2) of claims 47-63.

The exact same limitations upon which that reversal was based remain in independent claims 47 and 57.

Independent claims 68 and 71 contain similar limitations for which the same rationale upon which the BPAI reversed the prior 103 rejection may apply.

Under law of the case, res judicata, this panel should not reconsider the prior factual and legal conclusions of the prior panel on the same legal issue. Accordingly, this panel should reverse all rejections (because claims 47, 57, 68, and 71 are the only independent claims) appealed. The appellant splits the claims into 2 groups, 47/57, and 68/71 so that those groups do not stand or fall together for purposes of these arguments. However, the generic reasoning is presented in the following paragraphs.

37 CFR 41.54 requires the examiner, in post appeal prosecution, to take actions "to carry into effect the decision." The general rule of law is that "when a court decides upon a rule of law, that decision should continue to govern the same issues in subsequent stages in the same case." *Arizona v. California*, 460 U.S. 605, 618, 75 L. Ed. 2d 318, 103 S. Ct. 1382 (1983). "The doctrine prevents the relitigation of settled issues in a case, thus protecting the settled expectations of parties, ensuring uniformity of decisions, and promoting judicial efficiency." *Little Earth of the United Tribes, Inc. v. United States Dep't of Housing & Urban Dev.*, 807 F.2d 1433, 1441 (8th Cir. 1986)("Little Earth"). See *Morris v. American Nat'l Can Corp.*, 988 F.2d 50, 52 (8th Cir.1993) (quoting *Arizona v. California*, 460 U.S. 605, 618, 103 S.Ct. 1382, 75 L.Ed.2d 318 (1983)). This concept of repose is embedded in PTO practice, for example requiring group director approval to make a new and different rejection after a BPAI decision reversing the

examiner's rejection. In this specific case, law of the case is embedded in 37 CFR 41.54, which requires the post appeal examination to comport with the conclusions by the BPAI panel on issues raised and decided.

An issue raised and decided in BPAI 8/21/2008 decision was whether Von Kohorn and Saigh provided within the meaning of 35 USC 103 a suggestion for a "A system for distributing and redeeming electronic coupons comprising: ...second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon." The panel forming the BPAI 8/21/2008 decision concluded that Von Kohorn and Saigh did not suggest that set of limitations.

The prior panel stated "We find that the reason stated for modifying Von Kohorn (to allow convenient coupon redemption) is, in this specific instance, insufficient. Von Kohorn is not motivated by convenient redemption for the user - rather, Von Kohorn is motivated by collection of data on the behavior of its users. **Electronic issuance and redemption of the coupon of Von Kohorn would act to frustrate portions of Von Kohorn's invention, the dispensing and redemption of product-specific tokens, for example.** Von Kohorn's principal thrust is to gather information electronically about the habits of consumers between the decision to purchase and the actual purchase. \*\*\* The stated reason appears to us to be solely based upon impermissible hindsight. Accordingly, we reverse this rejection." Pages 36-37; bold added for emphasis. That is law of the case, and it forecloses reconsideration of whether Von Kohorn suggests, or Von Kohorn and Saigh suggest, electronic issuance and redemption of coupons. And the BPAI decision is authorized by three senior APJs, members of the trial section, Torczon and Medley, and vice chief APJ Moore, and therefore carries particular respect.

1. **ESTOPPEL - Independent claims 47 and 57**

a. **Von Kohorn, per se, rejections**

The examiner admits that Von Kohorn does not disclose electronic coupon redemption. ("Von Kohorn does not explicitly disclose remote electronic coupon redemption. OA 9:6.")

The examiner argues that Von Kohorn in any case suggests modifying itself to provide

electronic redemption. OA at 9:7-17 ("Hence, given the architecture described above for two way electronic communication, it is obvious that Von Kohorn could take advantage of Von Kohorn's architecture and perform remote coupon redemption via the electronic architecture of Von Kohorn's Fig. 29, 31. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper.").

In response, the applicant submits that argument is foreclosed by law of the case, given the BPAI 8/21/2008 decision. The BPAI 8/21/2008 decision also concludes that Von Kohorn fails to disclose or suggest electronic redemption of coupons, and in fact such a modification would "frustrate portions of Von Kohorn's invention, the dispensing and redemption of product-specific tokens, for example.". As the prior panel stated "We find that the reason stated for modifying Von Kohorn (to allow convenient coupon redemption) is, in this specific instance, insufficient. Von Kohorn is not motivated by convenient redemption for the user - rather, Von Kohorn is motivated by collection of data on the behavior of its users. Electronic issuance and redemption of the coupon of Von Kohorn would act to frustrate portions of Von Kohorn's invention, the dispensing and redemption of product-specific tokens, for example. Von Kohorn's principal thrust is to gather information electronically about the habits of consumers between the decision to purchase and the actual purchase. \*\*\* The stated reason appears to us to be solely based upon impermissible hindsight. Accordingly, we reverse this rejection." Pages 36-37. That is law of the case, and it forecloses reconsideration of whether Von Kohorn suggests electronic redemption. And the BPAI decision is authorized by three senior APJs, members of the trial section, Torczon and medley, and vice chief APJ Moore, and therefore carries particular respect.

**b. Von Kohorn and Saigh rejections**

The examiner argues in the alternative that Saigh motivates a modification of Von Kohorn to provide for electronic redemption of coupons. ("Hence, it is obvious that Saigh's use of Internet can be applied to Von Kohorn's coupon redemption to that Von Kohorn's users can redeem coupons using an electronic network like the Internet."). OA at 12:5-7.

In response, the applicant submits that rejection is also foreclosed by law of the case, and res judicata, given the BPAI 8/21/2008 decision. See BPAI 8/21/2008 decision pages 34-37 reversing the 103 rejections based upon Von Kohorn and Saigh of claims 47-63.

That decision reversed the rejection *inter alia* of claim 47 based upon Von Kohorn and Saigh. The current version of claim 47 contains all limitations relevant to *res judicata*. The only text deleted from the version of claim 47 pending 8/21/2008 and the version of claim 47 pending now, was "wherein said electronic coupon included data representative of the identity of a location at which additional coupon information resides." That recitation was irrelevant to the basis for the BPAI 8/21/2008 decision to reverse the Von Kohorn/Saigh rejection because it did not deal with claim 47's limitations relating to electronic redemption of coupons.

Claim 47, both then and now, recites the limitations upon which the BPAI 8/21/2008 decision reversed the Von Kohorn/Saigh rejection, specifically the goal of distributing and redeeming electronic coupons in the preamble, followed in the claim body by a system adapted to distribute the electronic coupon to the client system, to detect the electronic coupon on the client system, and to redeem that electronic coupon. Claims 47, both then and now, recite: "A system for distributing and redeeming electronic coupons comprising: a first server system... adapted for transmitting an electronic coupon to said client system over said communications channel; ... a second server system ... adapted to establish a connection with said client system and for detecting said electronic coupon ... said second server system further being adapted to redeem said electronic coupon.". Therefore, law of the case and *res judicata* bar rejection of claim 47 as obvious based upon Von Kohorn and Saigh. Independent claim 57 contains an equivalent (for the purpose of defeating the Von Kohorn/Saigh rejection) recitation, *inter alia*: "said client requesting information from said subsequent server; said subsequent server detecting said electronic coupon on said client; ... said subsequent server redeeming said electronic coupon". Claim 57 then and now recites corresponding limitations. Therefore, the rejections of claims 47 and 57 based upon D1 and D2 are barred by the BPAI 8/21/2008 decision.

**c. Von Kohorn, Saigh, and Cameron rejections**

The examiner responded to the applicants *res judicata* argument traversing the rejection of claim 47 based upon only Von Kohorn and Saigh, in the OA, by adding Cameron. Compare OA dated 12/20/2010, at 4, with OA dated 4/25/2011, at 1. Addition of Cameron does not avoid the *res judicata* because Cameron is cumulative to Saigh. In order to avoid adverse factual conclusions in case the panel reviews the arguments on the merits, the applicant first traverses the examiner's factual findings and conclusions regarding Saigh.

The examiner asserts that Saigh discloses electronic redemption of coupons. Saigh does not disclose electronic redemption of coupons.

What Saigh 14:15-15:10 discloses is that "The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand...". Saigh does not contain "redemption" or "redeem". Thus, Saigh does not disclose electronic redemption of coupons. Moreover, Saigh indicates that coupons are printed, and presented in paper format in the normal course of shopping, for redemption. This is clear from the only other two references in Saigh to coupons. The first reference explains how the coupons come to reside on a system available to a user, stating that "Coupling to merchants' terminals promotional system provides local merchants and the local business direct access to update their promotions and coupons." That discloses the merchants upload coupon information electronically to the Saigh system. The second and only other reference to "coupon" in Saigh is that "A printer 362 is provided to print coupons on demand, receipts and various reports for the users." Since this reference uses the term "coupons on demand" it logically applies to the Saigh 14:15-15:10 reference to coupons being downloaded by the user. That is the phrase "on demand" means on demand by the user to download the coupon to the user's terminal. Accordingly, what Saigh suggests is that a user download and then prints the coupons obtained by the coupons on demand function. Therefore, nothing in Saigh suggest the coupons are electronically presented during a user's purchase transaction in order to obtain a discount. Thus, Saigh does not disclose electronic redemption of coupons.

As a consequence, Saigh does not suggest providing electronic redemption of coupons. Therefore Saigh does not suggest modifying Von Kohorn to provide claim 47's "second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon."

Second, the applicant traverses the examiner's alleged factual conclusion regarding what the Board found Cameron to teach in the prior BPAI decision.

The examiner alleges that "Alternatively, Cameron discloses using the Internet or a network (5:13-16; Fig. 2) and redeeming coupons electronically via a network (Figs. 13, 15; 11:10-15). Examiner notes that the use of Cameron for these features is all ready affirmed by the

BPAI in this case 09/879,825 (see BPAI decision for 09/879,825 dated 8/21/2008 pages 31 -34 and page 37, "The Appellant's have not otherwise shown prejudicial error"). Cameron further discloses electronically using or redeeming coupons via a network (12:10-40; 20:5-20; 8:5-10; 9:40-45)."

In reply, the appellant submits that the BPAI 8/21/2008 decision found that the appellants arguments that Cameron was not analogous art failed to carry the burden of proof. What the BPAI decision affirmed was the rejection of claim 52, which relied upon the BPAI finding that Cameron suggested the use of a TCP/IP network, as defined by claim 52. This only required the BPAI panel to find that the appellant failed to carry its burden to show that Cameron was non analogous art. Nothing more. More specifically, it does not support the examiner's assertion that the BPAI panel found that Cameron suggesting modifying Von Kohorn to provide for "redeeming coupons electronically via a network".

Moreover, the examiner's prior rejection of claim 52 based upon Cameron, which was the rejection reviewed in the prior BPAI decision in this case, did not assert that Cameron suggested redeeming coupons electronically, and that prior BPAI did not rely upon Cameron for suggesting redeeming coupons electronically. Thus, the "the use of Cameron for these features [sic; redeeming coupons electronically] is **[NOT]** all ready affirmed by the BPAI in this case". Quoting the OA appealed with interpolation and bold indicating the appellant's contrary assertion of fact.

The appellant belabor's this point further, with further citations to the record of the prior appeal in this case. In fact, the examiner did not assert in the Examiner's Answer dated 6/27/2005, which was the Answer addressed by the BPAI 8/21/2008 decision, that Cameron suggested modifying Nichtberger to provide the function of "redeeming coupons electronically via a network". Instead, the examiner argued in that Answer that Cameron was analogous art to Nichtberger and Valencia. It was in support of Cameron being analgous art, that the examiner asserted that Cameron disclosed utilizing coupons. Examiner's Answer dated 6/27/2005, 25:16-18.

The BPAI 8/21/2008 decision stated at 33:15 that "We find these contentions unpersuasive." That statement referred to the immediately preceeding paragraph's stated contentions of the appellant, at 33: 9-14, which states: "that (1) there is no teaching, suggestion,



or motivation to 'further modify the already improper combination of Nichtberger and Valencia to further include the teachings of Cameron' (App. Br. at 24). The rationale for this argument is that Cameron is directed to a computerized order entry system and is non-analogous art to both Nichtberger and Valencia. (Id.)."

Those statements in the BPAI 8/21/2008 decision were in response to traverse of a 103 rejection of claim 52. Claim 52 depended from independent claim 47. See 4/6/2004 claims, pages 2 and 3. Claim 52 recited "A system according to claim 47 wherein said communications channel includes a TCP/IP based network and said coupon includes a data component.". The examiner's appealed 103 rejection of claim 52 was based upon Nichtberger, Valencia, and Cameron. Examiner's Answer dated 6/27/2005 8: 13-14. In rejecting claim 52, the examiner expressly relied upon Cameron to suggest using a "TCP/IP" network. That was in response to the examiner expressly finding that Nichtberger failed to disclose a TCP/IP network. Examiner's Answer dated 6/27/2005 8:19-21. And the examiner applied Cameron to suggest modifying Nichtberger to use a TCP/IP network. Examiner's Answer dated 6/27/2005 9:1-4. Thus, the prior rejection of claim 52 addressed in the BPAI opinion dated 8/21/2008 at pages 31-34 and 37 was not based upon Cameron suggesting "redeeming coupons electronically via a network" and the BPAI decision accordingly did not address and did affirm the rejection in reliance upon Cameron suggesting "redeeming coupons electronically via a network". Moreover, the examiner now relies upon Cameron for exactly the same reason as Saigh. As to Saigh, the examiner states that "Also, **Saigh further discloses the electronic redemption** of coupons:" OA at 27:15; bold added for emphasis. As to Cameron, the examiner states that "Alternatively, Cameron discloses using the Internet or a network (5:13-16; Fig. 2) and **redeeming coupons electronically** via a network (Figs. 13, 15; 11:10-15)." OA at 29:15-16; bold added for emphasis. The prior BPAI decision is law of the case and forecloses the Cameron based rejection. This is because the prior BPAI decision forecloses obviousness of a modification of Von Kohorn to avoid printing of coupons, prior to redemption. As the prior panel stated "We find that the reason stated for modifying Von Kohorn (to allow convenient coupon redemption) is, in this specific instance, insufficient. Von Kohorn is not motivated by convenient redemption for the user - rather, Von Kohorn is motivated by collection of data on the behavior of its users. Electronic

issuance and redemption of the coupon of Von Kohorn would act to frustrate portions of Von Kohorn's invention, the dispensing and redemption of product-specific tokens, for example. Von Kohorn's principal thrust is to gather information electronically about the habits of consumers between the decision to purchase and the actual purchase. \*\*\* The stated reason appears to us to be solely based upon impermissible hindsight. Accordingly, we reverse this rejection." Pages 36-27. Accordingly, the rejection based upon Von Kohorn and Cameron, as an alternative to Von Kohorn and Saigh, is barred for the same reasons that the rejection based upon Saigh. And since the examiner relies upon Cameron as an alternative to Saigh, the rejections based upon the combinations of Von Kohorn, Saigh, and Cameron, are barred.

## 2. ESTOPPEL - Independent claims 68 and 71

The foregoing arguments apply at least in part to claims 68 and 71 for the following reasons. The former BPAI decision reasoned that **"Electronic issuance and redemption of the coupon of Von Kohorn would act to frustrate portions of Von Kohorn's invention, the dispensing and redemption of product-specific tokens, for example."** Bold supplied for emphasis. Claim 68 recites the "electronically distributing and tracking redemption of coupons" which electronically transmits the coupon to the client system and then electronically tracks redemption. Specifically, claim 68 recites inter alia "A system for **electronically distributing and tracking redemption** of coupons, comprising: a server system ... programmed to respond ... by **transmitting** from said server system to a client computer associated with said particular user identification, **data defining a particular coupon**, ... said **server system being programmed to respond to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon** by comparing said coupon redemption data with said information regarding coupons redeemed in said database, **to thereby determine whether said particular coupon was previously redeemed.**" Like claim 47, claim 68 defines the goal of electronic distribution and tracking of redemption. Claim 68 differs from claim 47 by requiring tracking of redemption whereas claim 47 defines a server system "adapted to redeem said electronic coupon." Thus, claims 68 and 71 are not limited to provide both electronic distribution and redemption, only requiring electronic distribution and

electronic tracking of the redemption.

C. NON ESTOPPEL ARGUMENTS

Assuming arguendo, you determine estoppel is inapplicable, consider the arguments below.

D. WHY THE EXAMINER ERRED IN REJECTING INDEPENDENT CLAIMS 47, 57

Copied below is a claim chart comparing claim 47, the examiner's assertions in the OA regarding disclosure of Von Kohorn, D1, whether the applicant disputes those assertions, and if so, why.

1. Disputed factual assertions regarding D1

Claim 47	OA assertions, D1	Analysis
47. (Previously Presented) A system for distributing and redeeming electronic coupons comprising:	The OA fails to address this recitation with D1.	Disputed. D1 does not disclose a system for distributing and redeeming electronic coupons. D1 does not disclose electronic coupons.

<p>a first server system including a computer processor and associated memory,</p>	<p>OA at 6:11-12 states that "<b>This Central Station 12 of Von Kohorn functions as the Appellant's claimed central computer/main server system.</b>".</p>	<p>Disputed. <b>The OA corresponds the central station 12 to the claimed "first server system."</b></p>
	<p>OA at 2:1-3 state "Von Kohorn discloses a server system including a computer processor, associated memory, an input for receiving data, and an output for outputting data (Figs. 1, 3)".</p>	<p>D1 does not disclose "a first server system including a computer processor and associated memory". The OA asserts D1 Figs. 1 and 3 disclose such a server. They do not.</p>

		<p>Fig. 1 discloses a "central station 12" including "studio 14" and two remote receiver stations 16, 18. See Fig. 1 and its brief description at D1 4:8-15 (D1, in column:page format). D1 discloses that "FIG. 1 presents a simplified description of a system 10 wherein a central station 12 includes a studio 14, such as a television studio which broadcasts programs to many external or remote receiving stations, two such receiving stations 16 and 18 being shown by way of example." D1 6:44-48.</p> <p>Fig. 3 is a "detailed diagram of the system of Fig. 1." D1:4:19.</p> <p>Fig. 3 and its description do not disclose the central station 12 including a server system. Instead, Fig. 3 shows a set of electronic components, including microphone 56, keyboard, 58, encoder 60, modulator 62, oscillator 64, band pass filter 66, mixer 68, combiner 70, broadcast transmitters 72, 74; and TV game 52, video camera 54, and instruction entry unit 648. D1, 11:57 to 12:64.</p> <p>D1 Figs. 1, 3, therefore, do not disclose a server system "including a computer processor and associated memory."</p>
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		<p>D1, other than Figs. 1 and 3 does not disclose a server system "including a computer processor and associated memory." All references to computers in D1 are in association with the remote receiving stations (16, 19 and their response units 22) and structures that are not part of a central station.</p>
		<p>D1 teaches away from using a central computer for processing viewer responses. "A number of methods in accordance with aspects of the invention will now be described, the methods utilizing the electronic circuitry described herein. ... Its is noted that all of the methods described utilize electronic equipment at the locations of the viewer or listener to evaluate responses, and to award successful participants. The system does not require central computers, thereby obviating the need for simultaneously processing large numbers of viewer responses at a central location." D1, 66:3-30.</p>

	<p>OA at 6:16-18 asserts "Also, note that the central station of Von Kohorn functions as a central computer/main server system and has a computer and processing and data (Fig. 29, items 202, 902, 904; and following citation)."</p>	<p>Disputed.</p> <p>D1 does not disclose that the central station functions as a central computer/main server. Fig. 29, items 202, 902, 904 and the disclosures in D1 thereof do not support such a conclusion. The examiner admits at OA paragraph spanning pages 6 and 7 that what D1 discloses is that elements 202, 902, 904 may be located "on site" or "at" the central station 202. Nothing therein indicates that the central station includes a computer, or that the central station functions as a computer.</p>
<p>said first server system being connected by a communications channel to a client system,</p>	<p>OA at 6:11-13 asserts that "And, the separate Response Unit 22 of Von Kohorn, which is communication with the central station, functions as the Appellant's claimed client computer."</p>	<p>Disputed.</p> <p><b>The OA corresponds the response unit 22 to the claimed client system.</b></p>

	<p>OA at 2:1-3 state "Von Kohorn discloses a server system including a computer processor, associated memory, an input for receiving data, and an output for outputting data (Figs. 1, 3)".</p>	<p>Disputed.</p> <p>D1's central station 12 is not a first server system.</p> <p>D1 Fig. 3, broadband transmission from transmitters 72, 74, from central station 12 to remote receiving stations does constitute a "server ... connected by a ... communication channel".</p>
	<p>OA at 7:5-6 asserts that "Also, Von Kohorn further discloses two way communication between the central station and response unit (Figs. 1, 3, 22, 29, 30, 31; 90:60-91:45).".</p>	<p>Admitted, only as to the existence of two way communication. Communication from the response units are filtered; with only selected transmitted information reaching the central station. Communications occur along different communication channels.</p>



		<p>See Figs. 6, 22. Fig. 6, broadband communication channel 222 from central station 202 to remote receiving station 206. Fig. 6 includes modem 408 and telephone 280 providing for transmission to central station 202 of a bar code read by a bar code reader to transmit data printed by remote receiving station 206 in bar code format. The modem 408 and telephone line 280 are not part remote receiving station 206. However, description of these elements references Fig. 22, stating "Further example in the communication from a receiving station at a remote location to a central station will be described with reference to FIG. 22 wherein information as to a person's response can be outputted from the response unit 210 as digital signals and transformed by a modem to a signal format suitable for transmission via a telephone circuit, such as the circuit 280. The use of modems and a telephone circuit serves as an example in the practice of the invention for communication electronically from a remote receiving station to a central station, it being understood that other forms (not shown) of electronic or electro-optical communication may be employed."</p> <p>D1's description of Fig. 22 indicates that data in register 368 and accumulator 386 may be transmitted by modem to "receivers 632". D1, 61:34-38.</p>
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		<p>D1 states that "receivers 632 can correlate a score with a specific remote station. Thereby, the host 212, or other persons in charge of the quiz show or operation of the prerecorded programs, can be provided with response data". D1, 61:47-50.</p> <p>Fig. 22 shows the receives 632 are not part of the central station; instead they are part of the telephone system (PBX 622 and associated telephone hardware). D1 does not disclose how the host 212 is provided with response data received by receivers 632. Given the disclosures elsewhere in D1 that the response data received by the host 212 is identify of he winner and amount of prize, additional undisclosed functionality must be associated with receiver 632, that filters received information so that only winner and amount of prize, or the like information, is transmitted to the host 212.</p> <p>Unlike Fig. 3, Fig. 22 does not show a host. What this means is that the Figs. 8/22 disclosed communication of data from the response unit to the central station (1) is not a direct transmission, (2) is filtered, and (3) is not along the same communication channel as data transmitted from the central station to the remote stations.</p>
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	<p>OA at 8:14-16 asserts that "Also, this interpretation of Von Kohorn has already been affirmed by the BPAI (see BPAI decision on related case 09/451,558 dated 8/3/10 page 6)."</p>	<p>Disputed.</p> <p>As noted herein above the BPAI concluded that Von Kohorn discloses "that there is a communication link between the point of sale system 906 and the response unit or electronic coupon dispenser 206c through the data facility 904 and central station 202." That is not the same as alleged "two way communication".</p>
	<p>OA at 8:20-21 asserts that "Von Kohorn explicitly discloses electronic issuing of coupons (affirmed by CAFC in related cases 09/754,378 and 09/543,735). The"</p>	<p>Disputed.</p> <p>For the reasons noted herein above, the appellant does not agree that the CAFC affirmance in the foregoing two cases affirmed that "Von Kohorn explicitly discloses electronic issuing of coupons" and in fact is not relevant to what Von Kohorn discloses.</p>
	<p>OA at 9:1-3 assert that "Also, the CAFC indirectly affirmed the electronic redemption of coupons via claims dependent claims 86 and 108, respectively."</p>	<p>Disputed.</p> <p>For the reasons noted herein above, the appellant does not agree that the CAFC affirmance in the foregoing affirmed that D1 discloses "electronic redemption of coupons," and in fact is not relevant to what Von Kohorn discloses.</p>

<p>said first server system being adapted for transmitting an electronic coupon to said client system over said communications channel;</p>	<p>OA at 4:3-7 states "Hence, Applicant states that the claims can be interpreted as the functions of coupon distribution, analysis, and redemption all occurring at a central location or website. Von Kohorn does not explicitly disclose electronic forwarding of the coupon or electronic redemption of the coupon. Von Kohorn does not explicitly disclose wherein said coupon is an electronic coupon and said person presenting said coupon does so by transmitting said coupon over a network."</p>	<p>Disputed.</p> <p>The OA admits that D1 does not disclose a "first server system being adapted for transmitting an electronic coupon to said client system".</p> <p>D1 does not disclose an electronic coupon.</p> <p>D1 does not disclose a "first server system being adapted for transmitting... [a] coupon to said client system".</p>
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	<p>OA at 4:9-10 asserts that "However, Von Kohorn discloses electronic sending of coupon related information that is also related to redemption (40:10-15)."</p>	<p>Disputed.</p> <p>D1 40:10-15 discloses electronically transmitting sweepstake symbols to a redemption center, not electronically transmitting, or transmitting, coupons, from the central station 12, to a remote receiving station.</p>
	<p>OA at 4:11-14 asserts that "Also, Von Kohorn discloses that the response unit and a central computer are electronically connected over a network (Fig. 1, 3) and also several means for how the cumulative record data can be collected (claim 8, 9; 102:5-20; and, matrix in Specification)."</p>	<p>Disputed.</p> <p>First, as noted above, D1 does not disclose "a central computer". Central station 12 has no computer.</p> <p>Second, D1 also does not disclose "several means for how the cumulative record data can be collected."</p> <p>D1 claim 8 recites "wherein said cumulative record is a mailing piece". D1 claim 9 recites "a household member mailing said cumulative record to an organization for evaluation".</p> <p>D1, 102:1-5 indicates that the "matrices of the cumulative record 1018" is printed paper on paper.</p> <p>D1, 102:5-20 states that the cumulative records 1018 "can take the form of a mailing piece described in connect with Fig. 34."</p> <p>Thus, D1 discloses only one means, postal mailing of a paper document, for how the cumulative record data can be "collected."</p>

		Moreover, the OA does not cite the Figs. 8/22 disclosures. Figs. 8/22 disclose transmission only of winner information to a person at the broadcast station, not collection of cumulative at the central station.
	OA 4:14-15 continues "And, Von Kohorn discloses that the analyzing and tabulating can be performed by "computerized processing and analyses" (9:3-8; 9:33-40). Hence, as shown, Von Kohorn states that analyzing/tabulating/ etc can be performed by a computer."	Disputed. D1, 9:3-8 discloses that "evaluating" and "scoring"include analyzing, which includes "computerized processing". D1, 9:3-8 does not mention "tabulations."
	OA 4:16-17 continues "And, the MPEP states that automating a manual activity is obvious (MPEP 2144.04.III)."	Disputed. What MPEP 2144.04.III states in relevant part is that "The court held that broadly providing an automatic or mechanical means to replace a manual activity <b>which accomplished the same result is not sufficient to distinguish over the prior art.</b> ." Bold added for emphasis.

said client system including a computer processor and associated memory,	The OA fails to address this recitation with D1.	Admitted that the D1's response unit includes a computer processor and associated memory.
said client system being adapted for storing said electronic coupon in said memory;	The OA fails to address this recitation with D1.	<p>Disputed.</p> <p>D1 discloses a response unit storing a cumulative record in the form of print on paper. This print on paper does not constitute an electronic coupon. See D1, 3:3-13, forming part of the Summary of the Invention ( stating "The response units at individual shoppers' locations have means for dispensing individual coupons following a response and for compiling a cumulative record of products for which the shopper has requested or selected discount coupons. Such a cumulative record can take the form of a tape intermittently printed as coupons are requested. Whereas the coupons are dispensed individually when printed as described in connection with the drawings, the tape matrix having the cumulative coupon data printed thereon is temporarily retained in the response unit in the form of a tape.")</p> <p>D1, in connection with Figs. 6 and 22, discloses the response unit computer's electronic memory storing a record of the user's responses. That record does not constitute an electronic coupon.</p>

	<p>(second server system summary, in right hand column. The OA's assertions regarding the second server system recitations appear herein below.)</p>	<p>The OA relies upon the D1 Figs. 29-31 embodiment for the second server system recitations. Prior to discussing the OA assertions, is a summary of the D1 Figs. 29-31 embodiment.</p> <p>The Figs. 29-31 description indicates that the outputted record of a user's selections in the form of a tape, coupon, entry ticket or form is "carried by the player to the redemption facility 906." D1, 90:53-60. D1, 90:61-91-20 also indicates that the record of user's selections are also "recorded automatically also in a storage unit 940 of the data facility 904 via block 938". D1, 91:1-5 indicates that the user's selections in playing stations 206C are transmitted via "the communication system 910, particularly via the telephone lines 636 and the switchboard 622 to the data facility 904." D1, 91:5-20 explains that, once the user has carried the card 362 containing the user's selections to the redemption facility for redemption, "the redemption facility 906 communicates via link 926 to the data facility 904 ... flowed by a comparing or [sic; of] the data on the record copy of the data facility 904 with the record on the card 362."</p>
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	<p>(second server system summary, in right hand column. The OA's assertions regarding the second server system recitations appear herein below.)</p>	<p>Discrepancies result in "rejection of the card 362". The foregoing process does not require a computer server at the central station 12, and does not include communication of redemption information to the central station 12. D1, 92:45-58 indicates that a computed prize value is transmitted from the scoring computer 902 to the central station 202, and that the central station 202 broadcasts that computed prize value to all of "the response units 800 at playing stations 206C" so that all of the cards 362 are imprinted with the prize value, (thereby allowing presentation at the redemption facility 906 of the winning card 362 to result in award of the computer prize value to the winner).</p>
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<p>a second server system connected to said communications channel,</p>	<p>The OA at 5:7-12 asserts that "In further regards to claim 47, 57, Von Kohorn further discloses a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system (Von Kohorn for the multiple computers, 94:30-45; Von Kohorn for the detecting, 90:60-91:20; 92:30-60; also, note that what applies to the card can apply to coupons 94:1-14, 90:60-91:20)."</p>	<p>Disputed.</p> <p>D1 does not disclose a "second server system" because it does not disclose a "first server system"; that is the designation "second" is inaccurate because the central station is not a server system and therefore not a "first" such system.</p> <p>D1 does not disclose that "a second server system connected to <b>said</b> communications channel"</p> <p>D1 discloses a dedicated channel for communication from the central station to the response units 22.</p>
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		<p>The data facility 904 is not connected to the same channel connecting the central station 202 with the play stations 206C. See Figs. 29, 31. D1 discloses that data facility 904 receiving data from the play stations 206C.</p> <p>D1 discloses the data facility 904 having communication link 928 to central station 202. D1 does not disclose that communication link 928 is the communication channel that central station 202 uses to communicate with the play stations 206C. There, D1 does not disclose the data facility 904 connected to the same communication link the central station uses to communicate to communicate the play stations 206C. Therefore, D1 does not disclose "a second server system (aka data facility 904) connected to <b>said</b> communications channel (aka the broadcast communication channel the central station uses to communicate with the play stations 206C)".</p>
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		<p>D1, 94:30-45 discloses the relative locations of the central station 202, scoring computer 902, evaluation unit 808, and data facility 904. For example, it notes that "data facility 904 may be located distant from the central station, or may be located on site with the central station 202."</p> <p>However, D1, 94:30-45 does not address which communication channel they use.</p> <p>D1, 94:30-45 states that " In terms of construction of the system 900, the data facility 904 may be located distant from the central station, or may be located on site with the central station 202. Also, the scoring computer 902 and the evaluation unit 808 may be located at sites distant from both the central station 202 and the data facility 904 or, alternatively, either one or both of the computer 902 and the evaluation unit 808 may be located at the central station 202 or the data facility 904. Furthermore, while the playing stations 206C are located normally at considerable distance from the central station 202, such as in a different city, it is within the inventive concept to locate one or more of the playing stations 206C relatively close to the central station 202 as is done in the situation of a studio audience participating in a contest, or in the aircraft shown in FIG. 11. "</p>
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said second server system being adapted to establish a connection with said client system		Disputed that the data facility 904 is a "second" server. Admitted that the data facility 904 is "adapted to establish a connection with the client system".
and for detecting said electronic coupon stored on said client system,	The OA at 5:7-12 asserts that "... Von Kohorn for the detecting, 90:60-91:20; 92:30-60."	<p>Disputed.</p> <p>D1 does not disclose an "electronic coupon stored on" play station 206C.</p> <p>D1 does not disclose the data facility 904 "detecting [a] coupon stored on said client system".</p> <p>D1, 90:53-60. D1, 90:60-91-20 indicates that the record of user's selections are stored in the play station 206C as print on a card and also "recorded automatically also in a storage unit 940 of the data facility 904 via block 938". D1, 90:60 to 91-20 fails to disclose the storage unit 940 "detecting said electronic coupon stored on" play station 206C.</p>

		<p>D1,92:30-60 is irrelevant to the "detecting" by the second server computer limitation. It discloses (1) transmission of the scores (ambiguously by scoring computer 9002 or data facility 904) to central station 202, and (2) subsequent broadcast of the score and winner from central station to the play stations 206C. That fails to disclose the data facility 904 detecting an electronic coupon on the play station 206C.</p>
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<p>said second server system further being adapted to redeem said electronic coupon; and</p>	<p>OA fails to address this recitation with D1.</p>	<p>Disputed.</p> <p>D1 does not disclose a "server system further being adapted to redeem said electronic coupon;"</p> <p>D1 discloses no electronic coupon.</p> <p>D1 does not disclose the data facility 904 "being adapted to redeem" a coupon. Instead, D1 discloses that it is redemption facility 906 that is adapted to redeem a coupon.</p> <p>D1 discloses the redemption facility 906 being a place where a player presents his printed record of selections, demands a prize, and is awarded a prize if the printed record of the user's selections matches the data retrieved to the redemption facility 906 from the data facility 904 and shows that the user is entitled to a prize. See the summary of the D1 Figs. 29-31 embodiment, herein above.</p> <p>D1 does not disclose that data facility 904, which is what the OA corresponds to the claimed second server system, is adapted to redeem any coupon.</p>
	<p>OA at 5:14-15 asserts that "Also, note in the Applicant's stated interpretation above, the servers are all coming from the same central station/website"</p>	<p>Disputed.</p> <p>The applicant does not claim a "central station".</p> <p>The assertion that "Applicant's stated interpretation above, the servers are all coming from the same central station/website" is a mis-characterization of what the applicant previously stated, for the reasons noted herein above.</p>

	OA at 5:15-16 asserts that "And, Von Kohorn discloses several computers at the central station (94:30-45)"	Admitted. D1, 94:30-45 discloses that the data facility 90, the scoring computer 902, the evaluation unit, and play stations 106C, may be located "relatively close"; "on site with the central station"; or "at" the central station.
wherein said electronic coupon includes data uniquely identifying the coupon relative to all other coupons transmitted by said first server system;	The OA fails to address this recitation with D1.	Disputed. D1 does not disclose an electronic coupon. D1 does not disclose an "electronic coupon ... transmitted by said first server.' D1 does not disclose any "coupon[] transmitted by" central station 12, or 202.
wherein said associated memory of said first server system defines a database;	OA 2:4-9 asserts D1 discloses a memory that defines a database, without citation.	Disputed. D1 does not disclose memory associated a central station having "a computer processor and associated memory." D1 does not disclose the central station having the "associated memory" and therefore cannot disclose the "database".



<p>wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records;</p>	<p>OA 2:5-9 asserts "wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records (2:65-4:3; 3:31-37; 105:65-106:10; 105:15-23; claim 6; Figs. 33, 34; claim 27);"</p>	<p>Disputed.</p> <p>D1 fails to disclose the central station 12 having computer memory storing a database, or storing a database with the defined data (coupon offer, user data, targeting criteria).</p> <p>D1 fails to disclose the central station 12 storing available coupon offers, user records, or targeting criteria.</p> <p>D1, 2:65-4:3 and 3:31-37 disclose the following. At 3:20-27 (coupons that can be traced to a household having requested them); D1, 3:3-16 (cumulative record of product for which a consumer requested a coupon stored on a replaceable printed tape in the response unit); D1, 3:33-36 (identifying on each printed coupon product, stimulus resulting in coupon selection, household member).</p> <p>D1, 105:65-106:10 merely discloses that coupons are redeemed and "valuable information as to each person's desires is collected...."</p>
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		<p>D1, 105:15-23, is part of a paragraph describing channel filters in the response units 22 to "prevent the receipt of certain electronic signals not intended for the owners of" (D1, 105:3-5) so "the sender of the electronic signal, by including appropriate coded signal instructions, can select the types of information to be conveyed" (D1, 105:12-15). This passage is unrelated to a first server having a database.</p> <p>D1, claim 6 recites "assigning a personal identification reference element to each member of a household, ... determining the purchase behavior of individual members of a household by tabulating said surrendered coupons carrying incentives to purchase products selected by individual members of said household identified on said coupons and by analyzing said tabulation in the context of said cumulative record".</p> <p>Nothing therein discloses the central station storing the claimed database.</p>
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		<p>D1, claim 27 recites "said at least one coupon at least partially identifying said individual and at least one stimulus from said stimuli; redeeming said selected coupons with the purchase of a product; and reviewing redeemed selected coupons to determine effect of at least one of said stimulus upon comparison of redemption rates of said coupons for said variety of stimuli."</p> <p>Nothing therein discloses the central station 12 storing the claimed database.</p>
		<p>D1, Fig. 33 is a flow diagram that discloses in relevant part, step 1019, "Deduct presented records from cumulative records" which provides an analysis of sales lost due to failure of printed coupon to be redeemed. Nothing therein discloses the central station 12 storing the claimed database.</p>
		<p>D1, Fig. 34, element 1033, appears to be an exemplary cumulative record. Nothing therein discloses the central station 12 storing the claimed database.</p>
<p>wherein each one of said user records stores</p>		

<p>(1) a user identification that is different from all other user identifications stored in all other records of said user records,</p>	<p>OA at lines 11-12 asserts that "(1) a user identification that is different from all other user identifications stored in all other records of said user records (3:55-65; 2:20-30; Fig. 32; 3:30-37)"</p>	<p>Disputed.</p> <p>D1 fails to disclose that central station 12 stores a database, and therefore fails to disclose that such a database stores user records.</p> <p>D1, 3:55-65 discloses providing each individual of a household a unique identifier. D1, 2:20-30 discloses tracing coupons to individuals. D1, describes Fig. 32 as "FIG. 32 is a diagram of the method steps leading to shoppers' selection of a product coupon." Nothing in Fig. 32 appears relevant to this claim recitation. What these passages stand for is that D1 discloses the concept of unique user identifications; nothing about a database structure or the central station having such a database..</p> <p>D1, 3:30-37 discloses each coupon identifying product, stimulus, and member of household.</p>
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(2) information regarding coupons redeemed;	OA at 2:13 asserts "(2) information regarding coupons redeemed (2:20-30);"	Disputed. D1 fails to disclose that central station 12 stores a database, and therefore fails to disclose that such a database stores information regarding coupons redeemed. D1, 2:20-30 discloses tracing coupons to individuals.
(3) data indicating which of said available coupon offers are to be offered;	OA at 2:14-15 asserts "(3) data indicating which of said available coupon offers are to be offered (2:65- 4:3; 3:31-37; 105:65-106:10; 105:15-23);"	Disputed. D1 fails to disclose that central station 12 stores a database, and therefore fails to disclose that such a database stores data indicating which of said available coupon offers are to be offered. The OA cites to D1, "2:65- 4:3; 3:31-37; 105:65-106:10; 105:15-23" are identical to the OA cites in connection with the antecedent recitation in this claim 47 of "wherein said database stores coupon offer data defining available coupon offers." The citations here are no more relevant than they were herein above to the antecedent recitation.

<p>said first server system programmed to respond to receipt over a network of a coupon request prompt from said client system, said coupon request prompt including a particular user identification and identification of a particular one of said available coupon offers, by transmitting from said server system to said client system, data defining a particular coupon,</p>	<p>OA at 2:16-21 asserts "said server system programmed to respond to receipt over a network of a coupon request prompt, said coupon request prompt including a particular user identification, a particular network address, and identification of a particular one of said available coupon offers, by transmitting from said server system to said particular network address, data defining a particular coupon (3:30-37; 2:65-4:3; 2:20-30; 85:15-57)."</p>	<p>Disputed.</p> <p>D1 does not disclose "said first server system programmed to respond ".</p> <p>The central station 12 has no digital computer, as noted above. Therefore, I cannot be "programmed to respond."</p> <p>D1 does not disclose "said first server system programmed to respond to receipt over a network of a coupon request prompt from said client system."</p> <p>D1 does not disclose "transmitting from said server system to said client system, data defining a particular coupon." Instead, it discloses providing a TV-viewer specially marked papers to put into the viewer's response unit 22. D1, 16:59-65. ("As an illustration, a TV-viewer having a response unit (as described above) in his home, is provided with two materials or matrices to form hard copy outputted by the dispenser. For example, the matrices may be a paper tape comprised of 100 coupon sections, which tape is fed into the printer of the response unit, and a verification card having 100 spaces or boxes.")</p>
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		<p>D1 does not disclose "said first server system" responding to a "coupon request prompt including a particular user identification and identification of a particular one of said available coupon offers, by transmitting from said server system to said client system, data defining a particular coupon."</p>
		<p>As noted above, D1, 3:30-37 and 2:65-4:3 and disclose the following. At 3:20-27 (coupons that can be traced to a household having requested them); D1, 3:3-16 (cumulative record of product for which a consumer requested a coupon stored on a replaceable printed tape in the response unit); D1, 3:33-36 (identifying on each printed coupon product, stimulus resulting in coupon selection, household member); and D1, 2:20-30 discloses tracing coupons to individuals. D1, 85:15-57 discloses schemes for coding coupons; this passage does not disclose anything about a programmed server system.</p>

<p>wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification; and</p>	<p>OA at 3:1-4 asserts that "wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification (3:30-36)."</p>	<p>Disputed. D1, 3:30-36 discloses each coupon identifying product, stimulus, and member of household. D1, 3:30-37 fails to disclose D1's central station 12, transmitting to response unit, data defining a coupon. There is no such data, and therefore D1 fails to disclose "data defining said particular coupon."</p>
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<p>said first server system being programmed to respond to receipt from a coupon redemption network address of said second server system, of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database,</p>	<p>OA at 3:5-9 asserts that "said server system being programmed to respond to receipt from a coupon redemption address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed (2:20-27)."</p>	<p>Disputed.</p> <p>D1, 2:20-27 only discloses tracing coupons to individuals. As noted above, D1 discloses the coupons are printed paper. In fact, D1, 8:47-48 discloses that coupons are redeemed by mail or by presentation in a retail establishment. ("Coupons may be redeemed by mail or in retail establishments for cash, prizes or discounts.") D1 fails to disclose the central station 12 having a computer processor and memory, or that it is capable of being programmed, and therefore D1 cannot meet any of the other limitations in this claim recitation.</p> <p>D1 fails to disclose a "second server system" and the OA fails to identify any element in D1 as corresponding to a second server system.</p> <p>D1 fails to disclose "said first server system being programmed to respond to receipt from a coupon redemption network address of said second server system."</p>
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<p>to thereby determine whether said particular coupon was previously redeemed.</p>		<p>Disputed.</p> <p>D1, 2:20-27 only discloses tracing coupons to individuals. In fact, D1, 8:47-48 discloses that coupons are redeemed by mail or by presentation in a retail establishment. ("Coupons may be redeemed by mail or in retail establishments for cash, prizes or discounts.")</p> <p>D1 fails to disclose a response to receipt "of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database."</p> <p>D1 fails to disclose "said first server system being programmed to ... thereby determine whether said particular coupon was previously redeemed."</p>
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2. The Examiner's alleged Motivation to modify D1 in view of D1 to provide electronic redemption of coupons is improper

OA at 9:6-12 recites that:

Kohorn does not explicitly disclose remote electronic coupon redemption. However, Von Kohorn discloses remote redemption of coupons by mail or phone (87:55-65, " ... The coupon provides a discount for selected products, and may carry advertising. At block 846, the shopper transmits the coupon to a redemption center by any one of a variety of ways, such as, by mail or by telephone or in person. Then, at block 848, the shopper redeems the coupon and receives an award such as a discount on the purchase of a selected product.").

Disputed.

D1 does not disclose remote redemption of coupons by mail or phone. D1, 87:55-65 contradicts that assertion. Instead, it clarifies that the act of transmitting a coupon to a redemption center may be distinct from the act of redeeming the coupon. D1, 87:55-65 specifies one step for transmission (step 846) and another step for redemption (848). The distinction at D1, 87:55-65 between transmission of coupon to a redemption center and the act of redeeming is consistent with all of the examples and discussion of redemption in D1 prior to column 87. Accordingly, D1, 87:55-65 does not disclose "remote redemption of coupons by mail or phone."

OA at 9:12-16 asserts that:

Hence, given the architecture described above for two way electronic communication, it is obvious that Von Kohorn could take advantage of Von Kohorn's architecture and perform remote coupon redemption via the electronic architecture of Von Kohorn's Fig. 29, 31. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper.

In response, the alleged motivation in D1 to modify D1 is based upon a large number of erroneous assertions of fact and does not logically follow from the asserted facts.

The erroneous assertions of fact upon which this alleged motivation is based have been identified above. In summary, in fact:

D1 does not disclose "a first server system including a computer processor and associated memory". Central station 12 has no computer.

D1 does not disclose that the central station functions as a central computer/main server. Central station 12 has no computer.

D1 does not disclose the central station transmitting coupons to a response unit.

D1 does not disclose communications occurring along the same communication channels from the central station to and from the response units.

D1 does not disclose electronic coupons.

D1 does not disclose electronic redemption of coupons.

D1 does not disclose a "first server system being adapted for transmitting... [a] coupon to said client system".

D1 does not disclose a server using the broadband communication channel that the central station uses to broadcast to the response units.

D1 does not disclose an "electronic coupon" stored by a response unit or play station.

D1 does not disclose a computer (such as data facility 904) "detecting [a] coupon stored" by a response unit.

D1 does not disclose a "server system (such as data facility 904) further being adapted to redeem said electronic coupon;"

The assertion that "Applicant's stated interpretation above, the servers are all coming from the same central station/website" is a mis-characterization of what the applicant previously stated D1 does not disclose an "electronic coupon includes data uniquely identifying"

D1 does not disclose the central station having memory defining a database, or one defining user records, targeting criteria, and coupon offers.

D1 does not disclose the central station database storing information regarding coupons redeemed; available coupons to be offered

D1 does not disclose the central station "programmed to respond to receipt over a network of a coupon request prompt from said client system"

D1 does not disclose the central station "programmed to respond ... by transmitting to said client system, data defining a particular coupon, "

D1 fails to disclose the central station "being programmed to respond to receipt from a coupon redemption network address ... of coupon redemption data indicating an attempt to redeem said particular coupon", or the response being "redemption data with said information regarding coupons redeemed in said database"

D1 fails to disclose the central station providing result, "to thereby determine whether said particular coupon was previously redeemed."

D1 fails to disclose redemption of coupons by mail or phone.

The OA specifically reasons that "it is obvious that Von Kohorn could take advantage of Von Kohorn's architecture and perform remote coupon redemption via the electronic architecture

of Von Kohorn's Fig. 29, 31." The OA erroneously relied upon Figs. 29-31 for the propositions that "the central station of Von Kohorn functions as a central computer/main server system and has a computer and processing and data ". That statement is erroneous because D1 discloses no computer or memory being part of the central station. D1's central station has no computer to perform computerized redemption. Moreover, a claim 47 interpretation of the first server system and second server system would ignore the existence of claim 47's recitation of two server systems, and ignore the functionality defined by claim 47 of the first server system receiving data from "a coupon redemption network address of said second server system". Furthermore, the OA also fails to recognize that D1 discloses that the redeemer must physically appear at redemption center 906 with both winning coupon and corresponding card, in order to redeem. This is a general aspect applicable to D1's prize embodiments.

The OA also specifically reasons that motivation to modify D1 in view of D1 would be to better redeem in "a variety of ways" and "in a way that is more convenient to the shopper." However, the OA has not specifically identified a "way" that "would be more convenient to the shopper". D1 requires a coupon printed to paper and a corresponding card. D1 discloses no electronic coupon. How would "electronic redemption" of a paper coupon be a "way" that "would be more convenient to the shopper"? No such motivation is specified.

### 3. Addition of the Teachings of Saigh, D2, to D1

OA at 4:18 asserts that "Saigh discloses electronic redemption of coupons (14:15-15:10)." OA at 5:12-13 asserts that "said second server system further being adapted to redeem said electronic coupon (Saigh, 14:15-15:10)."

Disputed.

Saigh does not disclose electronic redemption of coupons. What Saigh 14:15-15:10 discloses is that "The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand...". Saigh does not contain "redemption" or "redeem". Thus, Saigh does not disclose electronic redemption of coupons. Moreover, Saigh indicates that coupons are printed, and presented in paper format in the normal course of shopping, for redemption. This is clear from the only other two references in Saigh to

coupons. The first reference explains how the coupons come to reside on a system available to a user, stating that "Coupling to merchants' terminals promotional system provides local merchants and the local business direct access to update their promotions and coupons." That discloses the merchants upload coupon information electronically to the Saigh system. The second and only other reference to "coupon" in Saigh is that "A printer 362 is provided to print coupons on demand, receipts and various reports for the users." Since this reference uses the term "coupons on demand" it logically applies to the Saigh 14:15-15:10 reference to coupons being downloaded by the user. That is the phrase "on demand" means on demand by the user to download the coupon to the user's terminal. Accordingly, what Saigh suggests is that a user download and then prints the coupons obtained by the coupons on demand function. Therefore, nothing in Saigh suggest the coupons are electronically presented during a user's purchase transaction in order to obtain a discount. Thus, Saigh does not disclose electronic redemption of coupons.

OA at 4:19 to 5:6 asserts that:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's electronic redemption of coupons to Von Kohorn's electronic coupon information and Von Kohorn's redemption of coupons at the merchant (8:43-50). One would have been motivated to do this in order to better allow shoppers to use and redeem coupons. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In response, the motivation is flawed because it is premised on the conclusion that Saigh discloses electronic redemption of coupons, and Saigh does not. As a consequence, Saigh does not suggest providing electronic redemption of coupons. Therefore Saigh does not suggest modifying Von Kohorn to provide claim 47's "second server system being adapted to establish a

connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon."

Moreover, D1 and D2 fail to disclose separate servers redeeming and communicating electronic coupons, transmission from a redemption server address to the server that provides the coupons, storage by the first server whether said particular coupon has been redeemed in said database for a particular user identification, and disallowing redemption of a particular coupon if comparing by the first server indicates that said particular coupon was previously redeemed, as defined by claim 47.

4. Addition of the Teachings of Cameron, D3, to D2 and D1

The OA at 12 asserts that Cameron discloses "'electronically using or redeeming coupons via a network" citing Figs. 13, 15; 11:10-15 and 12:10-40; 20:5-20; 8:5-10; 9:40-45. Admitted.

D3 describes Figs. 13, 15, as "FIG. 13 is a preferred order payment user interface for the billing module of FIG. 6. ... FIG. 15 is a preferred object inheritance structure for a payment object for the order capture module of FIG. 6. " D3, at 11:10-15 refers display of the customer's previous payment methods. See D3, 11:4-9. . It specifies that "payment methods may include a credit card, a check, a coupon, and/or a recovery coupon (i.e. gift certificate)." D3 also states that "If the allocation is incomplete, the total amount of the order will be applied to the first payment method, less any coupon or gift certificate."

The OA at 12:20 to 13:5 reasons that

Therefore, it would be obvious that Von Kohorn can utilize the electronic redemption of coupons via a network as shown in Cameron. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and

one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In response, the motivation is flawed. First, the statement "One would be motivated to do this to better redeem in "a variety of ways" is vague and indefinite, not stating what would be better, or what modification to D1 are suggested by D3. Second, the conclusion that "since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately" is clearly incorrect. D3 does not disclose many of the elements lacking from D1, including communications transmitting coupons occurring along the same communication channels as communications providing redemption information, that the same server system receiving redemption information is adapted for transmitting to the client system the electronic coupon, a server system detecting the electronic coupon on a client system, a server programed to receive and respond to coupon request prompt from said client system, and responding by transmitting to said client system, data defining a particular coupon, all as defined by claim 47.

Finally, since it appears that D3's system is the only location that stores the user's coupon information, there would be no motivation provide a system designed to determine whether a particular electronic coupon and previously been redeemed, which is defined by claim 47's "aid first server system being programmed to respond ... to thereby determine whether said particular coupon was previously redeemed." recitation. The basis for motivation to modify D1, or D1 and D2, in view of D3, to arrive at claim 47, are legally improper.

Claim 57 is non obvious over D1, D2, and D3, for the same reasons as claim 47.

E. WHY THE EXAMINER ERRED IN REJECTING INDEPENDENT CLAIMS  
68, 71

Unlike claim 47, Claim 68 does not recite "a second server system" or that the second server system is "connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon; and ". Accordingly, arguments noted herein above relating to the existence of



two server systems, with the second server system adapted to redeem an electronic coupon, and with the second server system adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system are not applicable to claim 68.

Like claim 47, claim 68 does recite "server system including a computer processor, associated memory" defining a database that "stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records"; that the server system is programmed to respond to a coupon request prompt, and that the server system is programmed to "respond to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed." Corresponding arguments noted for claim 47 for these limitations apply to claim 68. Claim 71 is non obvious over D1, D2, and D3 for the same reasons as claim 68.

F. WHY THE EXAMINER ERRED IN REJECTING DEPENDENT CLAIMS 64, 66, 69, 72

Claim 64 recites "The system of claim 47 wherein said first server system is programmed to store whether said particular coupon has been redeemed in said database."

The OA at 13:6-8 cites D1 2:20-30 as disclosing claim 64. D1, 2:20-30 discloses tracing coupons to individuals. D1, 2:20-30 does not disclose a first server system having a database and being programmed to store therein whether a particular coupon has been redeemed. D1 does not disclose a server system that is the server system that transmits coupons to a client system also "is programmed to store whether said particular coupon has been redeemed in" a database also storing "available coupon offers, user record data defining user records, and targeting criteria applicable to said user records." Therefore, the rejection of claim 64 is improper. Claims 66, 69, and 72 contain the same limitations. For the same reasons, the rejections of claims 66, 69, and 72 are improper.

- G. WHY THE EXAMINER ERRED IN REJECTING DEPENDENT CLAIMS 65, 67, 70, 73 ("wherein said first server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed")

Claim 65 recites "The system of claim 47 wherein said first server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed."

The OA at 13:9-14 asserts that:

Dependent Claims 65, 67, 70, 73. Von Kohorn further discloses the system of claim 66 wherein said server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed (2:20-30; and the forgery, authentication, validation protections of 90:60-91 :20; 92:30-60; 94:13-20; 95:3-10; also, note that what applies to the card can apply to coupons 94:1-14,90:60-91 :20).

D1 discloses requiring presentation of a card and a coupon having corresponding data in order to validate that a coupon showing winning data is valid. The winning card data is obtained at the redemption center from some other source, for comparison, to provide validation. D1 discloses the validation occurring at a redemption center, which is functionally and physically distinct from the broadcast station (central station). What D1 is designed to determine, is whether the coupon and card combination is valid, not whether the coupon was previously redeemed. In contrast, dependent claim 65 defines disallowing redemption of a coupon if said particular coupon was previously redeemed. The recitation "said coupon" requires identity with a previously submitted coupon, which would not be possible in D1's paper based system using a mutilated version of a previously redeemed coupon, because the mutilated version would not be identical to the redeemed version. An essential difference therefore between function of D1's

system and claim 65 is that claim 65 provides a mechanism for precluding redemption of an exact duplicate, by having a record of coupon identifications redeemed at the server system, against which to compare. There is no corresponding analog in D1. Therefore, D1 does not disclose, and does not suggest, the "programmed to disallow" based upon a previous redemption of "said particular coupon" defined by claim 65.

Claims 67, 70, and 73 contain the same limitations. For the same reasons, the rejections of claims 67, 70, and 73 are improper.

**V. 37 CFR 41.37(c)(1) CONTINUED**

**H.. 37 CFR 41.37(c)(1)(viii) - CLAIMS APPENDIX**

The brief includes an appendix containing a copy of the claims involved in the appeal.

**I. 37 CFR 41.37(c)(1)(ix) - EVIDENCE APPENDIX**

The brief contains an appendix complying with the requirement for such an appendix. However, no evidence is submitted.

**J. 37 CFR 41.37(c)(1)(x) RELATED PROCEEDINGS APPENDIX**

The brief contains an appendix complying with the requirement for such an appendix listing related proceedings.

**VI. 37 CFR 41.37 (c)(2)**

This brief does not include any new or non-admitted amendment or evidence.

**VII. 37 CFR 41.37 (d)**

This appeal brief complies with all the requirements of paragraph (c) of this section.

**VIII. 37 CFR 41.37 (e)**

This notice of appeal and appeal brief are timely filed, in view of the extension of time

also submitted.

Date: 9/26/2011

Respectfully Submitted,

/RichardNeifeld#35,299/

RICHARD NEIFELD, REG. NO. 35,299

Attorney of Record

Printed: September 26, 2011 (11:50pm)

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## **APPENDIX 1 - CLAIMS APPENDIX OF APPEALED CLAIMS**

### **IN THE CLAIMS**

1-46 (Canceled).

47. (Previously Presented) A system for distributing and redeeming electronic coupons comprising:

a first server system including a computer processor and associated memory, said first server system being connected by a communications channel to a client system, said first server system being adapted for transmitting an electronic coupon to said client system over said communications channel;

said client system including a computer processor and associated memory, said client system being adapted for storing said electronic coupon in said memory;

a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon; and

wherein said electronic coupon includes data uniquely identifying the coupon relative to all other coupons transmitted by said first server system;

wherein said associated memory of said first server system defines a database;

wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records;

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records,

(2) information regarding coupons redeemed;

(3) data indicating which of said available coupon offers are to be offered;

said first server system programmed to respond to receipt over a network of a coupon request prompt from said client system, said coupon request prompt including a particular user identification and identification of a particular one of said available coupon offers, by transmitting from said server system to said client system, data defining a particular coupon,

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification; and

said first server system being programmed to respond to receipt from a coupon redemption network address of said second server system, of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed.

48-56 (Canceled).

57. (Previously Presented) A method of distributing and redeeming an electronic coupon comprising the steps of:

establishing a connection over a communications channel between a client and a first server system;

transferring said electronic coupon from said first server system to said client;

establishing a connection over a communications channel between said client and a subsequent server;

said client requesting information from said subsequent server;

said subsequent server detecting said electronic coupon on said client;

establishing a connection between said subsequent server and said first server system, said first server system authenticating said electronic coupon and authorizing the redemption of said electronic coupon; and

said subsequent server redeeming said electronic coupon as a function of a transaction initiated between said client and said subsequent server;

wherein said electronic coupon includes data uniquely identifying said electronic coupon relative to all other coupons transmitted by said first server system;

wherein said associated memory of said first server system defines a database;

wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records;

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records,

(2) information regarding coupons redeemed;

(3) data indicating which of said available coupon offers are to be offered;

said first server system programmed to respond to receipt over a network of a coupon request prompt from said client, said coupon request prompt including a particular user identification and identification of a particular one of said available coupon offers, by transmitting from said first server system to said client, data defining a particular coupon,

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification; and

said first server system being programmed to respond to receipt from a coupon redemption network address of said subsequent server, of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed.

58-63. (Canceled).

64. (Previously Presented) The system of claim 47 wherein said first server system is programmed to store whether said particular coupon has been redeemed in said database.

65. (Previously Presented) The system of claim 47 wherein said first server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed.

66. (Previously Presented) The system of claim 57 wherein said first server system is programmed to store whether said particular coupon has been redeemed in said database.

67. (Previously Presented) The system of claim 57 wherein said first server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed.

68. (Previously Presented) A system for electronically distributing and tracking

redemption of coupons, comprising:

a server system including a computer processor, associated memory, an input for receiving data, and an output for outputting data;

wherein said memory defines a database;

wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records;

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records,

(2) information regarding coupons redeemed;

(3) data indicating which of said available coupon offers are to be offered;

said server system programmed to respond to receipt over a network of a coupon request prompt, said coupon request prompt including a particular user identification and identification of a particular one of said available coupon offers, by transmitting from said server system to a client computer associated with said particular user identification, data defining a particular coupon,

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification; and

said server system being programmed to respond to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed.

69. (Previously Presented) The system of claim 68 wherein said server system is programmed to store whether said particular coupon has been redeemed in said database.

70. (Previously Presented) The system of claim 68 wherein said server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed.



71. (Previously Presented) A method for electronically distributing and tracking redemption of coupons, comprising:

defining a database in memory of a server system, said server system including a computer processor, said memory, an input for receiving data, and an output for outputting data, a database;

storing in said database coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records;

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records,

(2) information regarding coupons redeemed;

(3) data indicating which of said available coupon offers are to be offered;

said server system responding to receipt over a network of a coupon request prompt, said coupon request prompt including a particular user identification and identification of a particular one of said available coupon offers, by transmitting from said server system to a client computer associated with said particular user identification, data defining a particular coupon,

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification; and

said server system responding to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed.

72. (Previously Presented) The method of claim 50 further comprising said server system storing in said database whether said particular coupon has been redeemed.

73. (Previously Presented) The method of claim 50 further comprising server system disallowing redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed.

RAN

Date/Time: September 26, 2011 (11:50pm)

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## **APPENDIX 2 - EVIDENCE APPENDIX**

There is no evidence to be cited herewith.

### APPENDIX 3 - RELATED PROCEEDINGS APPENDIX

There are related appeals.

The related appeals are:

Docket No.	AppNo	AppealNo	Appeal docket date
INVE0010-1	NO APPEAL		
INVE0010-2	NO APPEAL		
INVE0010-3	09/754,378	BPAI, 2005-2439	DECIDED
INVE0010-3	09/754,378	CAFC, 2007-1047	DECIDED
INVE0010-4	09/879,823	2005-2686	DECIDED
INVE0010-5	09/879,825	2007-0794	DECIDED
INVE0010-5	09/879,825	Not yet assigned (this appeal)	
INVE0010-6	10/871,381	2011-007957	4/28/2011
INVE0010-7	11/056,171	2011-010648	7/8/2011
INVE0010-8	12/247,549	Not yet assigned	
INVE0010-9	11/056,160	NO APPEAL	
INVE0014-1	09/321,597	BPAI	
INVE0014-1	09/321,597	CAFC	
INVE0015-1	09/451,558	2009-006888	DECIDED
INVE0016-1	09/537,793		
INVE0017-1	09/543,735		

Copies of the appeal decisions follow.

BTM

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